

### **REMARKS**

Responsive to the Office Action dated November 4, 2004, Applicant hereby makes the following response. Claims 1-29 remain pending for prosecution with Claims 1, 8, 9, 10, 15, 22 and 24 being independent.

#### **I. The 35 U.S.C. § 112 Rejection**

Claims 1-29 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, it was asserted that the intended meaning of the terms "shell material" is unclear with respect to the composition and location of the recited "shell" to the recorded media. In response to the Examiner's inquiry, Applicant's intended meaning for the recited "shell" is the outer layer portion of the recorded medium. Applicant has amended its claim to use the term "casing" instead of "shell" in order to make the intended meaning clear. The term "casing" is supported by the disclosure at, for example, page 23, line 16. Applicant therefore respectfully requests withdrawal of this rejection.

#### **II. The 35 U.S.C. § 103(a) Rejection**

Claims 1-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0031884 to Honda et al., or U.S. Patent No. 6,767,610 to Takahashi et al., or US Publication No. 2004/0161690 to Sakurai et al., each further in view of U.S. Patent No. 5,859,071 to Young et al.. For the following reasons, Applicant respectfully submits that the present invention is not obvious under 35 U.S.C. § 103(a) and requests reconsideration and withdrawal of this rejection.

First, Applicant respectfully submits that U.S. Publication No. 2004/0161690 A1 to Sakurai et al. is not prior art. Applicant's earliest effective filing date is March 12, 2003 which is

before the earliest filing date of the reference for 102/103 purposes which is the U.S. filing date of September 25, 2003. Applicant therefore respectfully requests withdrawal of the removal of rejection under 35 U.S.C. § 103(a) as it applies to this reference.

Turning now to the other cited references, in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Honda does not teach or suggest the claimed invention. Honda is directed to a cleaning tape for cleaning a surface of a magnetic head, particularly a magnetoresistive type head, used in a tape-type magnetic recording system, and a surface of a tape path. In particular, Honda discloses a cleaning tape comprising a nonmagnetic base film, an evaporated metal layer formed on the base film, and an inorganic protective film formed on the evaporated metal layer. The nonmagnetic base film may be composed of polyethylene terephthalate. The base film includes particles dispersed over it by a predetermined density. The particles can include emulsions of butadiene-acrylonitrile copolymers. Honda does not, however, teach or suggest a casing material for recording media comprising an alloy composed of 5-80% by mass recovery polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer. Honda does not teach or suggest an alloy at all. The composition of the base film is separate from the composition of the

particles. Moreover, there is no suggestion at all that the cleaning tape disclosed by Honda would be suitable for use as a casing material for recording media. To the contrary, the cleaning tape taught by Honda would be utterly unsuitable for use as a casing material due to its construction and thickness.

Similarly, Takahishi discloses a magnetic tape for use in a magnetic recording and reproduction system using an MR head. In particular, Takahishi teaches a magnetic tape comprising a non-magnetic layer containing a non-magnetic powder and a binder, which is substantially non-magnetic, and a magnetic layer containing a ferromagnetic powder and a binder on one surface of a support, and a back coating layer containing a carbon black on the other surface of the support for recording a signal. The support taught by Takahishi is a synthetic resin film of polyesters including polyethylene terephthalate. The binder used in the magnetic layer may include acrylonitriles. Thus, the composition of the support is different from the composition of the magnetic layer. Takahishi therefore does not teach or suggest an alloy composed of both polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer. Takahishi also fails to teach or suggest that the composition of the magnetic tape disclosed would be suitable for use as a casing material for recording media. Like Honda, the Takahishi tape would be utterly unsuitable for use as a casing material due to its construction and thickness.

The Office Action states that Young is cited as acknowledging "that there has been increasing interest in the recycling of the commingled plastics waste of automobiles. The different engineering plastics used in various parts of an automobile include polycarbonate, nylons, polyethylene terephthalate, acrylonitrile-butadiene-styrene, etc.." Thus, it is concluded that "in view of the common use of the polyethylene terephthalate and acrylonitrile-butadiene-

styrene alloy mixture in recording mediums, as shown by the various references above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a scrap or waste product polyethylene terephthalate moiety in the production thereof since such has been the primary focus of the industry to employ waste product bottle or polyethylene terephthalate for use in secondary compositions or products." However, once again, there is absolutely no teaching or suggestion by Young to provide a casing material for recording media composed of an alloy of polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer.

As discussed above, neither Honda nor Takahishi teach or suggest a casing material for recording media comprising an alloy of polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer. Young also fails to teach these elements of Applicant's claims. Moreover, the construction and thickness requirements of the Honda and Takahishi tapes teach away from the casing material of the present invention. There is absolutely no suggestion or motivation to modify or combine these reference teachings. There is also no reasonable expectation of success in achieving the invention as claimed when the cited references are modified or combined. The teaching or suggestion to make the claimed combination and there reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure as has been done in the Office Action. Finally, the references, even combined, do not teach or suggest all of Applicant's claim limitations. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, none of the references cited teach or describe *all* of the limitations claimed by Applicant in independent Claims 1, 8, 9, 10, 15, 22 and 24 and the claims depending therefrom. It would therefore not have been obvious to one of

ordinary skill in the art to provide a casing material for recording media comprising an alloy of polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer. Accordingly, Applicant's invention as claimed is not obvious under § 103 (a).

### **III. Conclusion**

Applicant respectfully requests withdrawal of the rejections and believes that the claims, as amended, represent allowable subject matter. However, if the Examiner desires, Applicant is ready for a telephone interview to expedite prosecution. As always, the Examiner is free to call the undersigned at 816.460.2516. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct any such fees from Deposit Account No. 19-3140.

Respectfully submitted,

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